

Appl'n No. 10/010,304
Reply to Notice of Non-compliant amendment dated 6/13/2006

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REMARKS

Applicant respectfully traverses the Notice of Non-complaint Amendment dated June 13, 2006.

The Notice states in part: "...the most recent office action, dated 1-13-06, points out why the claims are rejected over applicable statutes. A complete reply must include substantive arguments of why the claims are patentable over the rejections of record."

In response, Applicant now provides a legal argument and a factual argument as to why the Notice and the underlying Office Action are improper, and therefore why it is unnecessary for Applicant to provide further substantive remarks regarding the latest Office Action.

Claims 6-10, 14, 18-24 and 28, were previously identified by Primary Examiner Spear in his 8/10/05 Office Action as containing allowable subject matter. Applicant respectfully submits that Primary Examiner Spear's objections to those claims were rectified in Applicant's response dated 11/15/05.

Following the 8/10/05 Action, the case was passed to a different examiner.

The MPEP gives guidance in §706.04 for a situation where there has been an indication of allowable subject matter, and where there has been previous action by a different examiner:

"Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. (citing Amgen, Inc. v. Hoechst Marion Roussel, Inc., 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001).)"

In the unusual instance that it is necessary to reject a previously allowed claim, the MPEP in §706.04 further provides for the examiner to point out in the Office Action that the claim now being rejected was previously allowed by using the text from Form Paragraph 7.50:

Appl'n No. 10/010,304
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"The indicated allowability of claim [] is withdrawn in view of the newly discovered reference(s) to [new reference(s)]. Rejection(s) based on the newly cited reference(s) follow."

Thus, Form Paragraph 7.50 seemingly requires "newly discovered references" for rejecting claims that had been indicated by a previous examiner as being allowable subject matter. The 1-13-06 Action cites no such new references.

Thus, the 1-13-06 Action is improper, Applicant respectfully submits.

Moreover, the 6-13-06 Notice states that the 1-13-06 Office Action points out why the claims are rejected over applicable statutes. Applicant has studied the rejections in the 1-13-06 Office Action, and has the following observations: All of the claims that are presently rejected as of the 1-13-06 Office Action were previously rejected (specifically, on 8-27-03) under the same statutes, in view of the same references, and even in view of the same combination of references that are now freshly recited in the 1-13-06 Action. Applicants overcame these rejections previously, as evidenced by the indication of allowable claims by Examiner Spear in the 8-10-05 Action.

Accordingly, Applicant specifically requests that claims 6-10, 14, 18-24 and 28, having been previously identified by Primary Examiner Spear as containing allowable subject matter, be granted a Notice of Allowance, as Applicant respectfully submits that Primary Examiner Spear's objections to those claims were rectified in Applicant's response dated 11/15/05.

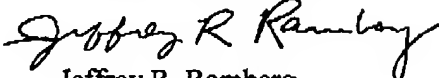
CONCLUSION

Applicant respectfully traverses the Notice of Non-compliant Amendment. Applicant respectfully submits that the burden is not on Applicant to provide arguments and/or amendments in view of the Office Action dated January 13, 2006. Rather, Applicant respectfully submits that the burden is first on the Office to justify the new rejections, and specifically to explain how they are in compliance with MPEP §706.04 regarding a new rejection of previously allowable claims, when they *prima facie* appear to be in conflict with this section of the MPEP.

Appl'n No. 10/010,304
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Should the Examiner deem that any further action on the part of Applicant would be desirable, the Examiner is invited to contact Applicant's undersigned representative.

Respectfully submitted,


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